

TRANSMITTAL OF APPEAL BRIEF (Small Entity)Docket No. **IPCP:107US**In Re Application Of: **Colson et al.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/931,492	08/16/2001	John M. Winter	24041	3621	4008

Invention: **GLOBAL INFORMATION NETWORK PRODUCT PUBLICATION SYSTEM****COMMISSIONER FOR PATENTS:**

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

March 15, 2007☐ Applicant claims small entity status. See 37 CFR 1.27The fee for filing this Appeal Brief is: **\$250.00**☒ A check in the amount of the fee is enclosed.☐ The Director has already been authorized to charge fees in this application to a Deposit Account.☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. **50-0822**. I have enclosed a duplicate copy of this sheet.☐ Payment by credit card. Form PTO-2038 is attached.**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

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U.S. Patent Application 09/931,492
Attorney Docket No. IPCP:107US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent Application No.: 09/931,492

Confirmation No.: 4008

Applicant(s): COLSON, Thomas J. et al.

Filed: 08/16/2001

For: **GLOBAL INFORMATION NETWORK PRODUCT
PUBLICATION SYSTEM**

TC/Art Unit: 3621

Examiner: John M. WINTER

Docket No.: IPCP:107US

Customer No.: 24041

Certificate of Mailing

I certify that this Brief on Appeal is being deposited on May 2, 2007 with the U.S. Postal Service as first class mail under 37 C.F.R. §1.8 and is addressed to Mail Stop Appeal Brief- Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Honorable Sir:

Appellants respectfully appeal the decision of the Examiner to finally reject Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44, as set forth in the final Office Action of December 15, 2006. A Notice of Appeal was timely filed by the Appellants on March 15, 2007. A check in the amount of \$250.00 for the required Appeal Brief fee is enclosed.

A **Claims Appendix** follows page 20 of this paper. 05/07/2007 MGE BREM1 00000040 09931492

An **Evidence Appendix** follows page 24 of this paper. 01 FC:2402

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A **Related Proceedings Appendix** follows page 25 of this paper.

REAL PARTY IN INTEREST

The Real Party in Interest in this matter is IP.com, Inc., assignee.

STATUS OF CLAIMS

The application originally contained 44 claims.

Claims 1, 12, 23, and 34 have been cancelled.

Claims 17, 18, 39, and 40 are objected to.

Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 stand as finally rejected.

Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 are the subject of this Appeal.

STATUS OF AMENDMENTS

There are no amendments filed subsequent to final rejection.

SUMMARY OF THE CLAIMED INVENTION

The present invention relates to system and a method of publishing a product document for clients for the purpose of publicly disclosing an invention to end users on the Global Information Network. The system includes a Web site system having a publicly accessible database for storing a plurality of product documents received from clients. The Web site also includes a search engine accessible to the end user. The search engine is in electronic communication with the database and can receive a search request from the end user, allowing the end user access to one or more of the product documents. The product document preferably includes a primary text file and attachment files which may include drawing files. The product documents are digitally notarized and time/date stamped.

1. Claim 11

11. A method of publishing a product document, said method comprising the steps of: providing a searchable document database (see Figures 20 and 22; see page/line as follows for a database without a reference number: 1/12; 3/4-6, 11-17 and 25-27; 4/1; 6/21; and 23/7-9; and see Figures 1 and 2 and page/line as follows for database (150): 9/14; 10/24; 19/9, 10 and 19-26; 20/1-6;

21/10-12, 19 and 20; 22/11 and 12; 23/19 and 20; 24/11; and 26/22) and a publication Web site (see Figures 1, 2, 3, 24, and 27-35 and page/line as follows for publication Web site (100): 9/12, 18, 27 and 28; 10/1, 8-10, 17, and 26-28; 11/2, 5, 6, and 21; 12/3, 7, 8, 13, and 20-24; 13/16, 22, and 23; 14/9; 15/5, 7-13, and 25; 18/24; 19/23; 22/17; 23/11; 25/22-27; 26/5-13, 25, and 26; 27/1, 6, 22-26; 28/2, 17; and 30/23) in communication with said document database (see previous reference), where said database is publicly accessible (see line/page: 3/12 and 25; 6/20 and 21; and 38/4 and 5); electronically receiving a product document transmitted by a client's computer (see Figures 1, 10-13 and 22 and page/line: 3/16 and 21-27; 11/3; 12/17-19, 27 and 28; 13/7, and 16-23; and 14/13 and 14), where said product document provides information regarding a commercially available product (see page/line: 2/27 and 28; and 3/1-3);

publishing said product document by adding said product document to said document database (see Figures 13 and 19 and page/line: 19/9-10), wherein said publishing is for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product (see Figures 13 and 19 and page/line: 2/27-3/3; 3/9-11; 3/20-22; 28/19-25); and,

digitally notarizing said product document (see Figures 1, 13 and 18 and page/line: 16/7-10; 18/17-19/5; 38/10) and obtaining a document notarization record (see Figures 13 and 18 and page/line: 18/17-19/5), said document notarization record including a timestamp and a digital fingerprint (see Figure 18 and page/line: 18/17-21).

2. Claim 33

33. A Web based system for publishing a product document, said system comprising:

a searchable document database (see Figures 20 and 22; see page/line as follows for a database without a reference number: 1/12; 3/4-6, 11-17 and 25-27; 4/1; 6/21; and 23/7-9; and see Figures 1 and 2 and page/line as follows for database (150): 9/14; 10/24; 19/9, 10 and 19-26; 20/1-6; 21/10-12, 19 and 20; 22/11 and 12; 23/19 and 20; 24/11; and 26/22), where said database is publicly accessible (see line/page: 3/12 and 25; 6/20 and 21; and 38/4 and 5); and

a publication Web site in communication with said document database (see Figures 1, 2, 3, 24, and 27-35 and page/line as follows for publication Web site (100): 9/12, 18, 27 and 28; 10/1, 8-10, 17, and 26-28; 11/2, 5, 6, and 21; 12/3, 7, 8, 13, and 20-24; 13/16, 22, and 23; 14/9; 15/5, 7-13,

and 25; 18/24; 19/23; 22/17; 23/11; 25/22-27; 26/5-13, 25, and 26; 27/1, 6, 22-26; 28/2, 17; and 30/23), said publication Web site including means for electronically receiving a product document transmitted by a client's computer (see Web server (110) Figures 1 and 2 and page/line: 10/18,19; 26/10-11, see channel partner Web server (275) Figure 1 and page/line: 10/4,5 and see Figures 10-13 and 22 and page/line: 3/16 and 21-27, 11/3; 12/17-19, 27 and 28; 13/7, and 16-23; and 14/13 and 14) and means for adding said product document to said database (see program (130) Figure 1 and page/line: 9/13-15 and see Figures 13 and 19 and page/line: 19/9-10), wherein said publication Web site is for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product (see Figures 13 and 19 and page/line: 2/27-3/3; 3/9-11; 3/20-22; 28/19-25) and wherein said product document provides information regarding a commercially available product (see page/line: 2/27 and 28; and 3/1-3); and,

means for digitally notarizing said product document (see notary website (300) Figure 1 and page/line: 10/14-16; and 27/2-4 and see Figures 13 and 18 and page/line: 16/7-10; 18/17-19/5; 38/10) and obtaining a document notarization record (see Web server (110) Figures 1 and 2 and page/line: 10/18,19; 26/10-11 and see Figures 13 and 18 and page/line: 18/17-19/5), said document notarization record including a timestamp and a digital fingerprint (see Figure 18 and page/line: 18/16-21).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,339,767 (Rivette et al.) in view of U.S. Patent No. 6,154,725 (Donner) and further in view of U.S. Patent No. 6,401,206 (Khan et al.)?

ARGUMENT

1. Whether Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,339,767 (Rivette et al.) in view of U.S. Patent No. 6,154,725 (Donner) and further in view of U.S. Patent No. 6,401,206 (Khan et al.)?

A.) Summary of the Rejection: In the Final Office Action dated 12/15/2007 (hereinafter referred to as "the Office Action," the Examiner rejected Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 as being unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,339,767 (Rivette et al.) in view of U.S. Patent No. 6,154,725 (Donner) and further in view of U.S. Patent No. 6,401,206 (Khan et al.).

The Examiner included U.S. Patent No. 6,947,909 (Hoke Jr.) in the header for the rejection, but in the next to last line on page 2 of the Office Action, stated that this reference had been withdrawn. The Hoke reference was not mentioned in the Examiner's arguments. Therefore, Appellants have not addressed the Hoke reference.

The Examiner stated: "Rivette et al. ('767) discloses a method of publishing a product document, said method comprising the steps of:

providing a searchable document database and a publication Web site in communication with a document database; (Figures 2 and 3)

Rivette et al. ('767) does not explicitly disclose "electronically receiving said product document transmitted by a client's computer, and publishing said client document by adding said client document to said document database", Donner ('725) discloses "electronically receiving said product document transmitted by a client's computer,(Figure 1) and publishing said client document by adding said client document to said document database".(Figure 2) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Donner ('725) method in order in order to decrease the latency in document processing by utilizing electronic transmission means.

Rivette et al. ('767) does not explicitly disclose "Digitally notarizing said product document and obtaining a document notarization record, said document notarization record including a timestamp and a digital fingerprint", Khan et al. ('206) discloses digitally notarizing said product document and obtaining a document notarization record, said document notarization record

including a timestamp and a digital fingerprint(Column 4, lines 45-63 [utilizes timestamp]; Abstract [discloses notary function] Figure 6, [digital fingerprint]) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Khan et al. ('206) method in order in order to decrease fraud by adding elements to verify authenticity such as time stamps.

Rivette et al. ('767) does not explicitly disclose "database is publically (sic) accessible", Donner ('725) discloses "database is publically (sic) accessible".(Figure 2; column 5, lines 44-57) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Donner ('725) method in order in order to form an IP portfolio utilize materila (sic) in the public domain."

B.) The References cited by The Examiner: For purposes of providing background, Appellants briefly discusses the references cited by the Examiner.

1.) Rivette et al.: Rivette et al. teaches a system, method, and computer program product for processing data. The system maintains first databases of patents, and second databases of non-patent information of interest to a corporate entity. The system also maintains one or more groups. Each of the groups comprises any number of the patents from the first databases. The system, upon receiving appropriate operator commands, automatically processes the patents in one of the groups in conjunction with non-patent information from the second databases. Accordingly, the system performs patent-centric and group-oriented processing of data. A group can also include any number of non-patent documents. The groups may be product based, person based, corporate entity based, or user-defined. Other types of groups are also covered, such as temporary groups. The processing automatically performed by the system relates to (but is not limited to) patent mapping, document mapping, patent citation (both forward and backward), patent aging, patent bracketing/clustering (both forward and backward), inventor patent count, inventor employment information, patent claim tree analysis, and finance.

2.) Donner: Donner discloses an intellectual property (IP) computer-implemented audit system to estimate a value of an intellectual property portfolio. The IP computer-implemented

audit system includes a computer program product storing instructions to be implemented by a computer. The IP audit system includes a first database storing first information relating to the intellectual property portfolio, and a database access and collection device accessing and retrieving the first information. The IP audit system also includes a second database storing empirical data relating to known IP portfolios, and a comparison device comparing the first information to the empirical data retrieved from the second database producing an IP worth indicator indicating the worth of the IP portfolio. The IP audit system is optionally implementable over a network architecture.

3.) Khan: Khan discloses a method and apparatus to create a portable digital identity of the individual that includes personal information, and may also include data representing the person's handwritten signature and one or more passwords. The digital identity optionally includes data representing seals, fingerprints and biometric information. The digital identity can be used to bind a verifiable electronic impression with an electronic document using electronic watermarks so that any modification in the document or the electronic impression bound to the document can be detected. The personal information included in the digital identifiers can include, in addition to a password, answers to questions that are composed by the user. The digital identity of a user can be created once and stored after encryption for protection. This digital identity can then be used by the signer to bind a unique instance of an impression of the digital identity to any document. Document and digital identity verification including verifying a cryptographic digital signature that establishes the integrity of the document, and ensures non-repudiation of origin to the extent that it was signed by the user's private key.

C.) Arguments

"There are three requirements to establish a *prima facie* case of obviousness: there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; there must be a reasonable expectation of success; and, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or

suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1483 (Fed. Cir. 1991)."

1. Claim 11

a.) Rivette does not teach a searchable database in communication with a publication Web site

Claim 11 recites: "providing a searchable document database and a publication Web site in communication with said document database, where said database is publicly accessible;" The Examiner stated: "Rivette et al. ('767) discloses a method of publishing a product document, said method comprising the steps of: providing a searchable document database and a publication Web site in communication with a document database; (Figures 2 and 3)" The Examiner further stated: "Rivette et al. ('767) does not explicitly disclose "database is publically (sic) accessible"

Thus, Rivette has been cited regarding "a searchable document database and a publication Web site in communication with said document database,"

The above statement by the Examiner does not contain any specific arguments, the statement merely points to Figures 2 and 3 without further elaboration. However, the crux of the Examiner's position was presented during a September 12, 2006 telephonic conference with the Examiner (as recorded in the Request for Reconsideration dated September 26, 2006), during which the relevance of Rivette to the above claim limitation was discussed. The Examiner asserted that Rivette teaches a publicly accessible database, based on the fact that Rivette shows an HTTP network in Figure 3. That is, an HTTP network is necessarily publicly accessible. However, the undersigned pointed out that the HTTP protocol is used in both public and non-public (i.e., controlled access) networks. That is, the use of HTTP protocol in a network does not mean that the network is publicly accessible. That is, the use of HTTP protocol is irrelevant to the issue of public accessibility. Alternately stated, the use of HTTP protocol cannot be used to determine if a system is public or non-public.

Further, Rivette is concerned with processing data. As stated in the first sentence of the Abstract: "A system, method, and computer program product for *processing* (emphasis added) data are described herein." In the Summary of the Invention, Rivette further describes the invention as

maintaining databases and groups, performing processing functions such as patent and document mapping, and having the ability to display hyperbolic trees. Rivette is silent regarding publication. Applicants performed a word search of Rivette and discovered that the word "publication" is not used in Rivette.

As well as failing to teach publication, Rivette also contains no suggestion regarding publication. Rivette presents a synopsis of his invention in col. 10, lines 59-67:

"The present invention is directed to a system, components of the system, a method, components of the method, and a computer program product for patent-centric and group-oriented data processing. Such processing includes, but is not limited to, reporting, analyzing, and planning.

The present invention is intended to aid a corporate entity in developing business-related strategies, plans, and actions. Accordingly, the present invention is also referred to herein as a business decision system and method."

The present invention is meant to be a very public and accessible process. That is, the goal of the present invention is to make a product document "sufficiently accessible to one skilled in the relevant art who exercise reasonable diligence" within the meaning of 35 U.S.C. §102(b). Hence, the present invention places publications in the public domain for purposes of establishing bars to patentability. On the other hand, Rivette is disclosing a system and method for internal use by a corporate entity as part of its decision-making process. This is the antithesis of a public and accessible process. Corporate viability and even survival require that business strategies and plans not be made accessible to competitors. Therefore, business entities go to great lengths to ensure the confidentiality and secrecy of meetings, documents, and data involved in decision-making/business plans. Thus, Rivette does not teach a Web publication site or include any motivation or suggestion regarding a Web publication site.

Thus, Rivette does not teach, suggest, or motivate "a searchable document database and a publication Web site in communication with said document database."

b.) Rivette teaches against a searchable database

As shown *supra*, Rivette teaches the processing of confidential and sensitive internal documents, such as: research and development information, financial information, patent licensing information, manufacturing information, and other relevant business information, which may, for example, include human resources information. Much of this information must remain confidential for survival of the business entity and other of the information must remain confidential by law. That is, Rivette teaches the opposite of the publication and public disclosure recited in Claim 11.

“A *prima facie* case of obviousness can be rebutted if one of the cited references teaches away from the claimed invention. See *In re Geisler*, 43 U.S.P.Q. 2d 1362, 1366 (Fed. Cir. 1997).”

c.) Donner does not teach receiving a product document

Claim 11 recites: “electronically receiving a product document transmitted by a client’s computer, where said product document provides information regarding a commercially available product;”

The Examiner stated: “Rivette et al. (’767) does not explicitly disclose “electronically receiving said product document transmitted by a client’s computer, and publishing said client document by adding said client document to said document database”

The Examiner further asserted: “Donner (’725) discloses “electronically receiving said product document transmitted by a client’s computer,(Figure 1). Appellants disagree. In general, Donner teaches retrieving data from public databases, not from a client’s computer: “Next, the data would be transmitted to a database access device 16 which would collect *various data* (emphasis added) from different on-line intellectual property databases 18.” That is, Donner teaches receiving data or patents from a public database, for example, LEXIS, rather than a client’s computer. In col. 6, lines 53-56 Donner states that a patent can be obtained using DIALOG. However, a patent from a publicly searchable database is not analogous to a product document produced by a client and provided by a client’s computer.

d.) Donner does not publish a product document

Claim 11 recites: “publishing said product document by adding said product document to said document database,” The Examiner stated: Donner (’725) discloses ...” publishing said client document by adding said client document to said document database”.(Figure 2)” Appellants

disagree. Donner does not teach any type of publication. Further, Donner contains no motivation to publish a product document. Donner is describing an analysis tool, not a means of putting a document in the public domain, col. 4, line 66 to col. 5, line 9:

“The intellectual property audit system according to the present invention may be used as an integrity check for acquisitions having assets involving a substantial intellectual property portfolio. The system could be used to compare the intellectual property portfolio to be acquired with other intellectual property portfolios having known market values to obtain an indicator of the intellectual property portfolio's worth. Depending on the quality of empirical data, the intellectual property audit system of the present invention could provide a qualitative and/or quantitative analysis of an intellectual property portfolio which is to be acquired.”

Donner contains no teaching, suggestion, or motivation regarding any part of the system shown in Figure 2 being involved in publication or having the capacity to publish. There is no teaching, suggestion, or motivation that Figure 2 is anything other than a non-public system and in fact, the use of Donner's system to perform integrity checks for acquisitions etc. clearly suggests that the system would not be publicly accessible.

Regarding publication and Donner, in the “Response to Arguments” portion of the Office Action, the Examiner stated: “The Applicant states the prior art fails to disclose a “publicly accessible web site” The Examiner responds that this feature is disclosed by the Donner reference, Figure 2; column 5, lines 44-57 *Donner discloses the usage of public databases such as DIALOG in order to retrieve product documentation.* (emphasis added).

The crux of the Examiner's argument has been italicized, however, this assertion is irrelevant and beside the point. Claim 11 does not recite accessing a public database, such as DIALOG, to obtain product information. Claim 11 very clearly recites receiving into a publicly accessible database a product document from a client's computer. Further, the fact that Donner teaches retrieving information from a public database has nothing to do with publishing product information.

e.) There is no motivation to combine Rivette and Donner

"Virtually all inventions are combinations of old elements. Therefore, an Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998).

When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references and the teachings of the references can be combined only if there is some suggestion or incentive to do so. *In Re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002), citing *In re Fine*. Hence, elements of separate patents cannot be combined when there is no suggestion of such combination in those patents. *Panduit Corp. v. Dennison Manufacturing Co.*, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987). Additionally, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills* 16 U.S.P.Q.2d 1430. Thus, the question of motivation to combine references is material to patentability and cannot be resolved on subjective belief and unknown authority. *In Re Lee, supra*.

"When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:(A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and **must suggest the desirability and thus the obviousness of making the combination**; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986)." (MPEP 2141(II)) (emphasis added).

The Examiner stated: "It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Donner ('725) method in order in order to form an IP portfolio utilize mater (sic) in the public domain." Appellants disagree.

Since Rivette is the primary reference, the Examiner's argument is based on the supposition that it would have obvious to modify Rivette to form a portfolio in the public domain. There is no basis for this statement. Rivette only teaches a closed, confidential database. Not only does Rivette

not have any motivation to form a portfolio in the public domain, such a portfolio could well be disastrous from a business and legal viewpoint. As has been shown, Rivette actually teaches against public disclosure of data. Further, Rivette does not contain any motivation to modify another database to form a portfolio in the public domain. Such a portfolio is simply outside of any teaching, suggestion, or motivation that can be attributed to Rivette.

Rivette does not suggest or motivate making the database of Figure 3, which contains highly confidential information, some of which is legally required to remain confidential, publicly accessible or linked to a publication website.

“The recognized law for combining references to support the conclusion that the claimed combination of structural features is directed to obvious subject matter requires that either the references expressly or impliedly teach or suggest the claimed combination, or the Examiner must present a convincing line of reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *See e.g., Ex parte Clapp*, 227 USPQ 972 (973) (PTO Br Pat. App. & Int. 1985); *In re Geiger*, 2 USPQ2d 1276 (CA, Fed. Cir. 1987).”

It is clear that the motivation to combine Rivette and Donner is not contained in Rivette or Donner. Thus, the Examiner must provide a convincing line of reasoning. In this regard, the Examiner stated: “It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Donner ('725) method *in order in order to decrease the latency in document processing by utilizing electronic transmission means*.” (emphasis added). This statement is clearly nonsensical with respect to the teachings of both Rivette and Donner. That is, both Rivette and Donner already use electronic transmission means. For example, Rivette shows network 312 in Figure 3, in which data is electronically transmitted and Donner teaches electronic transmission between device 4 and databases 5 in Figure 1. Alternately stated, the use of electronic transmission means as a motivation to modify or combine references is clearly inapplicable since the references already use electronic transmission means.

In fact, the Examiner has explicitly cited both of these electronic transmission

arrangements. For example, the Examiner stated: “Rivette et al. ('767) discloses a method of publishing a product document, said method comprising the steps of: providing a searchable document database and a publication Web site in communication with a document database;(Figures 2 and 3).” This is exactly an electronic transmission means. The Examiner also stated: “Donner ('725) discloses "*electronically receiving said product document transmitted by a client's computer*, (Figure 1) and publishing said client document by adding said client document to said document database". (Figure 2)” (emphasis added). This is clearly an electronic transmission.

The Examiner has cited decreasing latency in document processing as the general motivation for combining Donner with Rivette. The amorphous statement presented by the Examiner does not provide any support as to how or why latency is allegedly decreased by the combination of Rivette and Donner. There is no suggestion in Rivette that latency is a problem. Further, latency appears to be irrelevant with respect to the divergent problems addressed by Rivette, Donner, and the present invention. For example, decreasing latency will not improve the quality of the patent-centric and group-oriented data processing of Rivette or the quality of the analysis performed by Donner.

Thus, the Examiner has failed to provide any motivation or suggestion to combine or modify the references.

In the “Response to Arguments” portion of the Office Action, the Examiner stated: “In response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170USPQ 209 (CCPA 1971). References are evaluated/by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163USPQ 545 (CCPA) 1969. In this case,. (sic)”

Appellants respectfully submit that the Examiner has cited possibly relevant case law, but

has still failed to provide any motivation for combining the references. For example, regarding *In re McLaughlin* the Examiner fails to state “what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art,” and regarding *In re Bozek*, the Examiner has failed to state “what they suggest to one versed in the art, rather than by their specific disclosures.”

The cases cited by the Examiner do not relieve the Examiner of the obligation to provide adequate motivation.

f.) The Examiner has applied impermissible hindsight

“When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) **The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention**; and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).” (MPEP 2141(II) (emphasis added).

“Moreover, deficiencies of the cited references cannot be remedied by general conclusions about what is “basic knowledge,” or “common sense.” *Id.* Indeed, “to imbue one of ordinary skill in the art with knowledge of the invention ... when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *Id.*; *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed. Cir. 1983).”

As noted *supra*, there is no teaching, suggestion, or motivation in the cited references to modify Rivette to form the claimed invention, nor is there any convincing reason as to why an artisan would be motivated to combine the references. Therefore, any suggestion or motivation to modify Rivette is derived from Applicants’ disclosure. The Examiner must be pushed to a conclusion as to the patentability of Claim 11 by the teachings of the references themselves, or what is known in the art just before the invention was made. The Examiner cannot be drawn to a modification due to careful study of Applicants’ disclosure.

g.) Khan does not digitally notarize a product document with a timestamp

and a digital fingerprint

Claim 11 recites: “digitally notarizing said product document and obtaining a document notarization record, said document notarization record including a timestamp.” The Examiner has cited col. 4, lines 45-63 and the Abstract of Khan as teaching the above claim limitation. Appellants disagree.

The Abstract and col. 4, lines 45-63 teach using a personal public identity with respect to electronically signing a document. Khan does not teach, suggest, or motivate the document being a product document. In fact, signing a product document makes no sense. An electronic signature would only be applicable to a personal communication of some sort, for example, a letter, legal document, or memo. Khan reinforces the teaching of the document being a personal communication in Figures 6 and 7, which show a Notary-Public key. Clearly, a Notary Public would have no function with respect to a product document. Since Khan does not teach, suggest, or motivate a product document, Khan cannot teach notarizing a product document.

h.) Khan teaches against the invention recited in Claim 11

Claim 11 recites a process whereby information regarding a product is introduced to the public by publishing a document including such information. Specifically, Claim 11 recites a publicly accessible database for this purpose. In stark contrast, Khan teaches: “This present invention is designed to enhance the exchange of *personal, confidential, legal and proprietary information* (emphasis added) reliably through electronic means.” (col. 1, lines 14-16). Khan is teaching the polar opposite of what Claim 11 recites. The product document of Claim 11 is placed in a publicly accessible database and is meant to be disseminated to and viewed by the public. Confidential and proprietary information by definition cannot and is not made public. In virtually all cases, personal information is meant to remain non-public and typically, legal information also is kept confidential.

“A *prima facie* case of obviousness can be rebutted if one of the cited references teaches away from the claimed invention. See *In re Geisler*, 43 U.S.P.Q. 2d 1362, 1366 (Fed. Cir. 1997).”

i.) There is no motivation to combine Rivette and Khan

“Virtually all inventions are combinations of old elements. Therefore, an Examiner may

often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998).

When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references and the teachings of the references can be combined only if there is some suggestion or incentive to do so. *In Re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002), citing *In re Fine*. Hence, elements of separate patents cannot be combined when there is no suggestion of such combination in those patents. *Panduit Corp. v. Dennison Manufacturing Co.*, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987). Additionally, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills* 16 U.S.P.Q.2d 1430. Thus, the question of motivation to combine references is material to patentability and cannot be resolved on subjective belief and unknown authority. *In Re Lee, supra*.

"When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:(A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and **must suggest the desirability and thus the obviousness of making the combination**; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986)." (MPEP 2141(II)) (emphasis added).

The Examiner stated: "It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Khan et al. ('206) method in order in order to decrease fraud by adding elements to verify authenticity such as time stamps." Appellants disagree.

The Examiner has failed to explain or substantiate the above statement. The present invention is not concerned with fraud and electronic signatures as is Kahn. Digital notarizing is performed in the present invention to establish a time at which a document becomes of public record. In general, Kahn is addressing a completely different set of problems and concerns than the

present invention or the other references cited by the Examiner. Kahn is teaching a public portable identity. Rivette states: "A system, method, and computer program product for *processing* (emphasis added) data are described herein." (first sentence of the Abstract). Donner teaches an intellectual property (IP) computer-implemented audit system for estimating the value of an IP folder (Abstract). Different than all the references cited by the Examiner, the present invention teaches publishing a product document to establish a bar to patentability.

In the "Response to Arguments" portion of the Office Action, the Examiner stated: "In response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In *re* Nomiya, 184USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In *re* McLaughlin, 170USPQ 209 (CCPA 1971). References are evaluated/by what they suggest to one versed in the art, rather than by their specific disclosures. In *re* Bozek, 163USPQ 545 (CCPA) 1969. In this case,. (sic)"

Appellants respectfully submit that the Examiner has cited possibly relevant case law, but has still failed to provide any motivation for combining the references. For example, regarding *In re McLaughlin* the Examiner fails to state "what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art," and regarding *In re Bozek*, the Examiner has failed to state "what they suggest to one versed in the art, rather than by their specific disclosures."

The cases cited by the Examiner do not relieve the Examiner of the obligation to provide adequate motivation.

For all the reasons noted above, Claim 11 is patentable over the cited references. Claims 2-10, 13-16, and 19-22, dependent from Claim 11, enjoy the same distinction with respect to the cited references.

"If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

2.) Claim 33

The Examiner stated: "Claim 33 is in parallel with claim 11 and rejected for the same reasons." Therefore, the arguments presented *supra* with respect to Claim 1 are applicable to Claim 33 and Claim 33 also is patentable over the cited references. Claims 24-32, 35-38, and 41-44, dependent from Claim 33, enjoy the same distinction with respect to the cited references.

"If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

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Conclusion

For the reasons set forth above, Appellants respectfully submit that Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 are non-obvious under 35 U.S.C. §103(a) over U.S. Patent No. 6,339,767 (Rivette et al.) in view of U.S. Patent No. 6,154,725 (Donner) and further in view of U.S. Patent No. 6,401,206 (Khan et al.) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over the cited references.

Accordingly, Appellants prays that this Honorable Board will reverse the Examiner's rejection of Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44.

Respectfully submitted,

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Dated: May 2, 2007
CPM/
Attachment

CLAIMS APPENDIX

Reprinted herebelow are the claims involved in this appeal:

2. The method of claim 11, wherein said product document comprises a primary document and one or more attachment files.

3. The method of claim 2, wherein said attachment files include a sample deposition statement.

4. The method of claim 2, wherein said attachment files include an image of a sales brochure.

5. The method of claim 2, wherein said attachment files include an image of a purchase order.

6. The method of claim 2, wherein said attachment files include an image of a sales invoice.

7. The method of claim 2, wherein said attachment files include an image of a commercial Web site page.

8. The method of claim 2, wherein said attachment files include an image of a printed advertisement.

9. The method of claim 2, wherein said attachment files include a video clip.

10. The method of claim 2, wherein said attachment files include an audio clip.

11. A method of publishing a product document, said method comprising the steps of:

providing a searchable document database and a publication Web site in communication with said document database, where said database is publicly accessible;

electronically receiving a product document transmitted by a client's computer, where said product document provides information regarding a commercially available product;

publishing said product document by adding said product document to said document database, wherein said publishing is for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product; and,

digitally notarizing said product document and obtaining a document notarization record, said document notarization record including a timestamp and a digital fingerprint.

13. The method of claim 11, wherein said step of digitally notarizing said product document and obtaining a document notarization record is performed by a notarization vender Web site in communication with said database.
14. The method of claim 11, further comprising the step of charging said client a fee for adding said product document to said database.
15. The method of claim 14, wherein said fee is paid before said product document is added to said database.
16. The method of claim 11, further comprising the step of recording the number of times said product document is accessed by end users.
19. The method of claim 11, further comprising the step of collecting and adding bibliographic data to said product document.
20. The method of claim 11, wherein said product document is transmitted by said client's computer via one of a plurality of transfer protocols determined by said client.
21. The method of claim 20, wherein said plurality of transfer protocols includes the HTTP and FTP.
22. The method of claim 11, wherein said product document is published on a restricted basis for access only by users and user groups selected by said client.
24. The system of claim 33, wherein said product document comprises a primary document and one or more attachment files.
25. The system of claim 24, wherein said attachment files include a sample deposition statement.
26. The system of claim 24, wherein said attachment files include an image of a sales brochure.
27. The system of claim 24, wherein said attachment files include an image of a purchase order.
28. The system of claim 24, wherein said attachment files include an image of a sales invoice.
29. The system of claim 24, wherein said attachment files include an image of a commercial Web site page.
30. The system of claim 24, wherein said attachment files include an image of a printed advertisement.
31. The system of claim 24, wherein said attachment files include a video clip.

32. The system of claim 24, wherein said attachment files include an audio clip.

33. A Web based system for publishing a product document, said system comprising:

a searchable document database, where said database is publicly accessible; and

a publication Web site in communication with said document database, said publication Web site including means for electronically receiving a product document transmitted by a client's computer and means for adding said product document to said database, wherein said publication Web site is for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product and wherein said product document provides information regarding a commercially available product; and,

means for digitally notarizing said product document and obtaining a document notarization record, said document notarization record including a timestamp and a digital fingerprint.

35. The system of claim 33, wherein said means for digitally notarizing said product document and obtaining a document notarization record is provided by a notarization vender Web site in communication with said database.

36. The system of claim 33, further comprising means for charging said client a fee for adding said product document to said database

37. The system of claim 36, wherein said fee is paid before said product document is added to said database.

38. The system of claim 33, further comprising means for recording the number of times said product document is accessed by end users.

41. The system of claim 33, further comprising means for collecting and adding bibliographic data to said product document.

42. The system of claim 33, wherein said product document is transmitted by said client's computer via one of a plurality of transfer protocols determined by said client.

43. The system of claim 42, wherein said plurality of transfer protocols includes the HTTP and FTP.

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44. The system of claim 33, wherein said product document is published on a restricted basis for access only by users and user groups selected by said client.

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EVIDENCE APPENDIX

No additional evidence is being submitted with this appeal.

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RELATED PROCEEDINGS APPENDIX

Upon information and belief, no appeals or interferences are known to Appellants, which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.